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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,583	12/17/2001	David A Stout	T3392-000000	5426

181 7590 03/30/2005

MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

PHAM, MINH CHAU THI

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/015,583	Applicant(s) STOUT ET AL.	
	Examiner Minh-Chau T. Pham	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Upon consideration of the 1.131 declarations and exhibits filed on November 1, 2004, claims 1-33 are rejected under 35 U.S.C. 102(a) since the invention was known or used by others in this country based upon a public use or sale of the invention less than one year prior to the effective filing date of the instant application.

The 1.131 declarations and exhibits filed on November 1, 2004 establish that within one year of the effective filing date of the instant application (filed December 17, 2001). Applicant sold the instant invention (mail sorting and handling room) to a customer (Pennzoil-Quaker State Company) located in the state of Texas, United States of America prior to December 7, 2001.

Applicant apparently allowed Pennzoil-Quaker State Company to use the claimed invention without limitation, restriction, or obligation of secrecy. "Public use" of a claimed invention under occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor". In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). The presence or absence of a confidentiality agreement is not itself determinative of the public use issue, but is one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention.

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Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986). See Ex parte C, 27 USPQ 2d 1492, 1499 (Bd. Pat. App. & Inter. 1992). The record lacks any evidence that the inventor or assignee maintained any control whatsoever over the use or disposition of instant invention sold to Pennzoil-Quaker State Company.

In view of the evidence of record, the claimed invention was subject to knowledge or use that was accessible to the public. "The statutory language 'known or used by others in this country' (35 U.S.C. 102(a)), means knowledge or use which is accessible to the public". Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). The knowledge or use is accessible to the public if there has been no deliberate attempt to keep it secret. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). When the inventor or someone connected to the inventor puts the invention on display or sells it, there is a "public use" within the meaning of 35 U.S.C. 102 even though by its very nature an invention is completely hidden from view as part of a larger machine or article, if the invention is otherwise used in its natural and intended way and the larger machine or article is accessible to the public. In re Blaisdell, 242 F.2d 779, 783, 113 USPQ 289, 292 (CCPA 1957); Hall v. Macneale, 107 U.S. 90, 96-97 (1882); Ex parte Kuklo, 25 USPQ 2d 1387, 1390 (Bd. Pat. App. & Inter. 1992).

Accordingly, since the instant invention (mail sorting and handling room) was "known or used by others" (at least by Pennzoil-Quaker State Company) in this country

before the effective filing date of the instant application, the claims are properly rejected under 35 USC 102(a) per MPEP 706.02(c) and 2132-2133.03(e)(7).

Note also that affidavits or declaration submitted under 37 CFR 1.131 to swear behind a reference may constitute, among other things, and admission that an invention was "complete" before the filing of an application. See In re Foster, 343 F.2d 980, 987-88, 145 USPQ 166, 173 (CCPA 1965); Dart Indus. v. E. I duPont de Nemours & Co., 489 F.2d 1359, 1365, 179 USPQ 392, 396, (7<sup>th</sup> Cir. 1973).

### ***Response to Amendment***

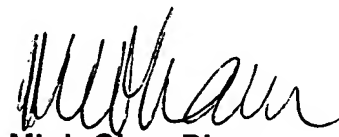
The declarations filed on November 1, 2004 under 37 CFR 1.131 are sufficient to antedate and overcome the publication to Miller (US 6,737,029). However, the evidence of record establishes that the inventive mail sorting and handling room was "known or used by others" in this country before the effective filing date of the instant application sufficient to reject the pending claims under 35 USC 102(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

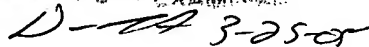
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Minh-Chau Pham  
Patent Examiner  
Art Unit: 1724  
March 25, 2005

DUANE SMITH  
SUPERVISORY PATENT EXAMINER

 3-25-05